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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,250	07/05/2000	Barry Cavill	LE9-00-043	4231

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EXAMINER

LEE, TOMMY D

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 11/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/610,250	CAVILL ET AL.	
	Examiner	Art Unit	
	Thomas D. Lee	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>8</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office action is responsive to applicant's AMENDMENT, filed September 4, 2002. Claims 1-20 are pending.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,361,134 (Hu et al.).

Hu et al. teach a stand-alone printing apparatus for transferring one or more digital photographs captured by an external camera to a printable medium (MDPS 10 (column 4, lines 8-11)); remote device 16; photograph scanned into MDPS utilizing scanner (column 2, lines 37-42)), the printing apparatus comprising: an input member for receiving one or more digital photographs recorded on computer readable memory associated with the external camera (column 4, lines 41-45); an image processing system for generating an image corresponding to each digital photograph (processing means 12 (column 4, lines 11-19)); an integrated user interface for selecting the one or more digital photographs to be transferred to the printable medium (visual display device 18, keyboard 20 (column 4, lines 46-57)); and a print control for producing on the printable medium a pixel pattern associated with the selected digital photographs, wherein the user interface is dynamically expandable (control module 22 (column 4, line 62 – column 5, line 21)) and further wherein the printing apparatus is capable of

calculating the pixel pattern to be printed on the printable medium and printing digital files, the printing and calculating being independent of an external host device (housing 11 contains all necessary logic and circuitry (column 4, lines 8-11)). The image processing system is dynamically expandable in functionality through the utilization of one or more plug-in modules, and comprises at least one drive for receiving a computer readable medium, wherein the computer readable medium comprises instructions for dynamically expanding the user interface, and comprises one or more plug-in modules (column 4, line 67 – column 5, line 2) comprising a sequence of instructions (note Figs. 4-8).

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al. as applied to claim 9 above, and further in view of U.S. Patent 5,543,925 (Timmermans). Claim 14 is also rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al. in view of Timmermans.

Hu et al. do not teach an ability to store setting and user selections on a removable storage media. However, Timmermans teaches a playback apparatus which utilizes a removable storage module 460 which is used for storing user-sources picture parameter data (column 22, lines 5-39). This allows a user to save picture parameter data for future playback devices (column 4, lines 25-30), thereby eliminating the need to manually input the parameter data for each reproduction. Therefore, it would have been

obvious for one of ordinary skill in the art to modify the teaching of Hu et al. by providing a removable memory module such as taught by Timmermans.

6. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al. as applied to claim 7 above, and further in view of U.S. Patent 6,012,070 (Cheng et al.).

Hu et al. do not teach an image processing system further comprising template definition and printing, wherein the template definition comprises one or more items selected from the group consisting of photo images, background art, images and text selections, or comprises the position, size and physical characteristics corresponding to the items. Cheng et al. teach a method for defining and printing templates, such as graphics, variable text and images (column 6, lines 36-57). The ability to manipulate the position, size and physical characteristics of the templates, while not mentioned by Cheng et al., is a well-known editing function that would have been an obvious modification to one of ordinary skill in the art. Providing template definition and printing allows a user to customize documents more efficiently, and thus it would have been obvious to one of ordinary skill in the art to modify the teaching of Hu et al. by providing a method for defining and printing templates, as taught by Cheng et al.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al. in view of Timmermans as applied to claim 14 above, and further in view of Cheng et al.

The reasons for rejection of this claim are the same as set forth above with respect to claim 11.

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al. in view of U.S. Patent 5,339,172 (Robinson).

Claim 16 further recites an image processing system comprising the ability to independently enhance one or more images from each other on the same page. This feature, while not taught by Hu et al., is well known in the art. For example, Robinson teaches segmentation of an input image, and each segmented portion is enhanced independent of the enhancement of other portions (column 7, lines 7-30). Robinson realized that different types of images (high frequency, low frequency, line/text, continuous tone) needed to be enhanced using different methods so that none of the images appearing on a document are degraded. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Hu et al. by allowing for independent enhancement of images as taught by Robinson.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al. in view of Robinson as applied to claim 16 above, and further in view of Timmermans.

The reasons for rejection are the same as set forth above with respect to claim 10.

10. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al. in view of Robinson as applied to claim 16 above, and further in view of Cheng et al.

The reasons for rejection are the same as set forth above with respect to claims 11-13, respectively.

Response to Arguments

11. Applicant's arguments filed in response the rejection of the above claims as set forth on pages 2-6 of the prior Office action dated June 5, 2002 have been fully considered but they are not persuasive.

Regarding base claims 1 and 7, applicant asserts, on pages 5 and 6 of AMENDMENT, that there is no teaching in Hu et al. of a stand-alone photoprinter for transferring one or more digital photographs captured by an external digital camera to a printable medium, or an input member for receiving one or more digital photographs recorded on computer readable memory associated with the digital camera. To the contrary, as set forth above, Hu et al. teach the stand-alone printing apparatus (MDPS 10 (column 4, lines 8-11)) and the input member for receiving one or more digital photographs recorded on computer readable memory associated with the external camera (column 4, lines 41-45).

Regarding dependent claim 10 and base claim 14, applicant asserts, on pages 7 and 8 of AMENDMENT, that Timmermans does not resolve the deficiency of Hu et al. regarding the input member. This argument is not persuasive, since the input member is taught by Hu et al., as mentioned above.

Applicant further states, on page 8, that Timmermans teaches away from the claimed invention by requiring an external host device for calculating and printing digital photographs. However, Timmermans was cited for its teaching of storage of setting and user selections on a removable storage media. Hu et al. already teaches applicant's limitation of calculating and printing being independent of an external host device

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(housing 11 is a single stand-alone unit containing all necessary logic and circuitry for scanning, printing, copying, faxing (column 4, lines 8-11)).

Regarding dependent claims 11-13, applicant asserts, on pages 9-11 of AMENDMENT, that the deficiencies of Hu et al. are not resolved by Cheng et al. Namely, applicant asserts that there is no teaching, suggestion or motivation for combining Hu et al. and Cheng et al.; for Cheng et al. requires an external computer system to generate the document to be printed which is then transferred over a telephone line to the external printing facility, whereas Hu et al. disclose a multi-functional printing system. In response to applicant's argument, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves *or in the knowledge generally available to one of ordinary skill in the art*. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would have recognized that providing template definition and printing, as taught by Cheng et al. (column 6, lines 36-57) allows a user to customize documents more efficiently, regardless of whether or not the customized documents are to be transferred to another device for printing, and thus it would have been obvious to one of ordinary skill in the art to apply such a teaching to the stand-alone device taught by Hu et al.

Regarding dependent claim 15, applicant, on pages 11 and 12 of AMENDMENT, restates the alleged deficiencies of Hu et al., Timmermans and Cheng et al. These alleged deficiencies in the references have been addressed above.

Regarding base claim 16, applicant asserts, on pages 12-15 of AMENDMENT, that Robinson does not resolve the deficiencies of Hu et al. Namely, applicant asserts that Robinson fails to disclose or suggest the capability to independently enhance one or more images from each other on the same printed page. However, Robinson teaches that a document, with up to four image types, may be classified or segmented distinctly (column 7, lines 52-58).

Regarding dependent claims 17-20, applicant, on pages 15-18 of AMENDMENT, restates the alleged deficiencies of Hu et al., Timmermans, Cheng et al. and Robinson. These alleged deficiencies have been address above.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (703) 305-4870. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (703) 308-7452. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Thomas D. Lee
Primary Examiner
Art Unit 2624

tdl
November 27, 2002